

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
ON APPEAL BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Patent Application of:
William J. Veeneman et al.

Appellant: Gift Certificate Center, Inc.

Application No.: 09/610,158

Confirmation No.: 3096

Filed: June 30, 2000

Art Unit: 3628

For: MULTI-MERCHANT GIFT REGISTRY

Examiner: I. N. Borissov

MAIL STOP APPEAL BRIEF – PATENTS
COMMISSIONER FOR PATENTS
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450

Dear Commissioner:

APPELLANT'S REPLY BRIEF

Appellant's Reply Brief was timely filed pursuant to 37 CFR §1.192 because it was filed within two months of 20 July 2009, which is the date on which the Examiner filed the Examiner's Answer.

Appellant believes that the claims appealed are patentable as argued in the Appeal Brief and this Reply Brief. If the Examiner has any questions concerning this Reply Brief or the Arguments presented herein and feels that an interview may be helpful in resolving the issues on appeal, attorneys for the Appellant would urge the Examiner to contact the attorneys for Appellant to arrange an interview.

Appellant's attorneys respectfully solicit the Board to remand this case to the Examiner with instructions to allow the case pursuant to 37 CFR §1.197(a).

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being transmitted via the Office electronic filing system in accordance with § 1.6(a)(4).

Dated: September 16, 2009

Signature: /James M. Graziano/ (James M. Graziano)

SUMMARY OF CLAIMED SUBJECT MATTER

Appellant's claims are drawn to a unified gift registry that serves a plurality of merchants. The gift registrant uses a portable data input and storage device to identify the gifts that are to be added to the registrant's gift registry, where each item tagged by the gift registrant includes the identification of the merchant who offers the selected gift. The gift registry enables a prospective purchaser to review all of the items for the selected registrant which are listed in the gift registry, including the identification of the merchant in whose store the registrant tagged the gift.

REBUTTAL OF ARGUMENTS PRESENTED IN THE EXAMINER'S ANSWER

Rejection of Claims 9 – 12 Under 35 USC §251

Examiner's Position – Improper Recapture Under 35 USC §251

In the nine years of prosecution of this Reexamination, the Examiners have avoided addressing the issue of the unnecessary addition of the limitation of "kiosk" to the independent claims. In the Preliminary Amendment dated 30 June 2000, Appellant deleted the reference to the "kiosk" from claim 9, since this structure was an unnecessary, erroneous, and gratuitous addition to the original patent. The term "kiosk" was inserted in claim 9 and is not a necessary element required to traverse any rejection of the original claims, as witnessed by claim 13 of the original patent, which fails to have such a limitation. Thus, the removal of the term "kiosk" is not improper recapture, and Appellant's amendment entails removal of the entire reference to the kiosk, including the phrase "disposed proximate the stores of a plurality of merchants in a shopping area, each of said merchants participating in the gift registry", which phrase modifies the term "kiosk" since this phrase is descriptive of the kiosk.

The reissue claims are for the same invention as disclosed as being the invention in the original patent, as required by 35 U.S.C. §251, where:

- (A) the claims presented in the reissue application are described in the original patent specification and enabled by the original patent specification such that 35 U.S.C. §112 first paragraph is satisfied; and
- (B) nothing in the original patent specification indicates an intent not to claim the subject matter of the claims presented in the reissue application.

In addition, the claims presented in the reissue application do not impermissibly recapture canceled subject matter, pursuant to the guidelines for impermissible recapture set forth by the Court of Appeals for the Federal Circuit in *Clement*, 131 F.3d at 1468-69, 45 USPQ2d at 1164:

"The first step in applying the recapture rule is to determine whether and in what aspect the reissue claims are broader than the patent claims. ... The second step is to determine whether the broader aspects of the reissue claims relate to surrendered subject matter. To determine whether an Appellant surrendered particular subject matter, we look to the prosecution history for arguments and changes to the claims made in an effort to overcome a prior art rejection."

In particular, the rule for impermissible recapture dictates that, if the claim limitation now being omitted was originally presented to make the claims allowable over a rejection made in the original application, the omitted claim limitation relates to subject matter previously surrendered by the Appellant, and impermissible recapture exists. In the original patent application, a single Office Action was issued on 20 June 1997, rejecting claims 1 – 14 under 35 U.S.C. 103(a) as being unpatentable over the publication article titled "Here Comes the (New) Bridal Registry" which appeared in the *Chain Store Age Executive*, October 1992, as well as by Appellant's admitted prior art discussed in the Background Of The Invention. In response to the 20 June 1997 Office Action, Appellant filed an amendment on 12 September 1997 and amended independent claims 1 and 9 (but not independent claim 13) to traverse the Examiner's rejection of claims 1 – 14, with claim 9 being illustrative of these amendments:

9. A system for registering items selected by a registrant from a plurality of participating merchants for subsequent communication to a prospective purchaser, the system comprising:

a gift registry kiosk disposed proximate the stores of a plurality of merchants in a shopping area, each of said merchants participating in the gift registry, the gift registry kiosk having a computer system containing identifying information about a registrant, the information for each registrant including at least one name for the registrant and a list of potential gifts which the registrant has identified;

a portable input and storage device for use by the registrant with a plurality of participating merchants, the input and storage device being capable of receiving and storing information regarding the registrant's desired gifts including the merchant each desired gift is from, wherein the

input and storage device stores a unique identifier for the particular merchant each desired gift is from;

a transfer device connected to the computer system that receives the information regarding the registrant's desired gifts from the portable input and storage device and transfers the information to the computer system; and

a prospective purchaser interface device that allows a prospective purchaser to view a list of the goods desired by the registrant wherein the list includes information about the particular merchant each gift is from.

Appellant added the limitation of a kiosk for use by the registrant to input the gift and merchant data. The arguments made by Appellant in the 12 September 1997 amendment to present these amendments were:

"The claims as amended are drawn to a gift registry that serves a plurality of merchants each having a store in a shopping area. Neither Applicants' admitted prior art nor the publication article is drawn to a registry serving a plurality of merchants, each merchant having a store in a shopping area. In fact, the publication article inferentially teaches away from the registry serving a number of stores in a shopping area. The registry in the publication article serves a number of stores under common ownership in a chain of stores. Typically the individual stores making up the chain of stores are located distant from one another in order to attract customers from a number of spatially distant areas, as distinct from the present invention in which the registry serves a number of different stores in a shopping area."

Nothing in these arguments refer to a "kiosk", and the arguments instead are directed to the distinguishing factor of a gift registry system that serves many merchants, each having a unique identifier, where the gift information is correlated with the selected merchant via the unique merchant identifier. Therefore, Appellant's substitution of "gift registry computer system" in claim 9 maintains the distinguishing characteristics of Appellant's invention over the cited references, which is the provision of a gift registry system for a plurality of merchants, with the registrant entering registrant gift data to indicate not only the identity of the selected gift but also the unique identity of the merchant who sells the selected gift. The more general terminology of "gift registry computer system" is supported by the disclosure of the embodiment of Figure 3 and the associated description in column 6 of the patent. Thus, the terminology "gift registry computer system" is more appropriate for use in independent claim 9 than the terminology "kiosk". In addition, the limitation "kiosk" is not addressed in Appellant's arguments in the 12 September 1997 amendment

or necessary to distinguish over the cited references as evidenced by the allowed independent claim 13 which does not contain such a limitation. Therefore, the amendments to independent claim 9 do not represent impermissible recapture of canceled subject matter.

Rejection Of Claims 9 – 14 Under 35 U.S.C. §103(a)

In the Examiner's Answer, the Examiner addresses Appellant's arguments against the obviousness rejections of claims 9 – 14 by presenting arguments supporting each reference individually, but one cannot show obviousness by discussing references individually where the rejections are based on combinations of references. Appellant's analysis of the cited references in the Appeal Brief was intended to accurately characterize the cited references and is not intended to show non-obviousness by attacking the references individually. Only by understanding the metes and bounds of the teachings of the references can the issue of non-obviousness properly be addressed. Therefore, the following comments are directed to the various combinations of references used by the Examiner in rejecting Appellant's claims 9 – 14.

Rejection Of Claims 9 – 14 Under 35 U.S.C. §103(a) As Being Unpatentable Over Chain Store Age In View Of McCalley et al.

The Examiner concurs with Appellant's argument that Chain Store Age fails to show or suggest storing merchant identification information (10.02).

The Examiner concurs with Appellant's arguments that McCalley et al. fails to show or suggest a unified database of gift registry information (10.04).

The Examiner then attempts to argue that McCalley et al. shows storing merchant identification information, and Chain Store Age shows a unified database of gift registry information; therefore, Chain Store Age + McCalley et al. = Appellant's claimed subject matter.

However, the Chain Store Age Publication discloses a traditional merchant-exclusive gift registry system wherein a bride can scan a single store's SKU numbers into the system to generate a list of desired gifts. As noted on pages 58 and 62:

"With the new-generation system, the bride actually walks the store with a consultant to find what she wants. As she picks out items, the consultant scans them with a handheld, portable laser scanner," he says.

When the bride and the consultant return to the store's bridal registry office, the consultant downloads the scanner information by batch to the registry computer.

Also on page 62:

Moreover, when a customer buys a gift from the registry list, the system automatically removes that item from the list as soon as it is rung up at the point of sale. The on-line, real-time removal of items from the list dramatically reduces the incidence of duplicate buys, thereby also reducing returns, Asher says.

The Chain Store Age system does not store merchant identification information, since the gift registry is exclusively used in a single merchant's store, and does not cover multiple merchants. In fact, the entirety of the description, as highlighted by the above quotes from the article, is devoid of even a hint of multiple merchants, since the system is exclusively single merchant-centric and not extendible to multiple merchants. In fact, the concepts of multiple merchants and a unified database spanning multiple merchants are contrary to all aspects of the teachings of the Chain Store Age article.

In addition, the McCalley et al. Patent operates seriatim to enable a customer to initiate a shopping session and purchase goods from each store in the electronic mall, with the transaction being completed before the customer leaves the store. Again, as with the Chain Store Age Publication, the various stores are each independently operational; and the system of the McCalley et al. Patent simply provides the customer with a single gateway by which to browse the various stores in the electronic mall on an insular basis, with each store maintaining their own inventory information, and wherein "Each node has a unique appearance and structure. The appearance of the node constitutes what the subscriber is being shown and told at that point of his shopping excursion." (column 19, lines 14 – 22) Therefore, each store is treated as a separate node, with no linking among the stores. There is a single comment in the McCalley et al. Patent that a gift registry could be an application (column 22, lines 9 – 13) for use in a particular store. However, there is no disclosure in the McCalley et al. Patent of a unified database of gift registry information, where the data entries are distinguished by a "unique identifier associated with the particular merchant having each of the desired gifts," as is specifically recited in

Appellant's independent claims. In fact the additional applications suggested by McCalley are customer-centric, such as a "list of groceries" (column 22, line 7) and a "price, sex, age, etc. and a size reminder server" (column 22, lines 14 and 15), not merchant identifier centric as claimed in Appellant's claims.

Therefore, both references treat the shopping experience as an individual store-centric experience and no customer gift registry data and no merchant identification data are stored in a common database, especially since the McCalley et al. Patent is shopping oriented and fails to teach a gift registry system. The references, therefore, are devoid of Appellant's claimed "a portable input and storage device ... receiving and storing information regarding the registrant's desired gifts including the merchant each desired gift is from, wherein the input and storage device stores a unique identifier for the particular merchant each desired gift is from" or "a prospective purchaser interface device that allows a prospective purchaser to view a list of the goods desired by the registrant wherein the list includes information about the particular merchant each gift is from."

Rejection Of Claims 9 – 14 Under 35 U.S.C. §103(a) As Being Unpatentable Over Chain Store Age In View Of Brumback et al.

The Examiner concurs with Appellant's argument that Chain Store Age fails to show or suggest storing merchant identification information (10.02).

The Examiner concurs with Appellant's arguments that Brumback et al. fails to show or suggest a unified database of gift registry information (10.07).

The Examiner then attempts to argue that McCalley et al. {sic} and Brumback et al. show storing merchant identification information, and Chain Store Age shows a unified database of gift registry information; therefore, Chain Store Age + Brumback et al. = Appellant's claimed subject matter.

However, the Chain Store Age Publication discloses a traditional merchant-exclusive gift registry system wherein a bride can scan a single store's SKU numbers into the system to generate a list of desired gifts. As noted on pages 58 and 62:

"With the new-generation system, the bride actually walks the store with a consultant to find what she wants. As she picks out items, the consultant scans them with a handheld, portable laser scanner," he says.

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Moreover, when a customer buys a gift from the registry list, the system automatically removes that item from the list as soon as it is rung up at the point of sale. The on-line, real-time removal of items from the list dramatically reduces the incidence of duplicate buys, thereby also reducing returns, Asher says.

The Chain Store Age system does not store merchant identification information, since the gift registry is exclusively used in a single merchant's store, and does not cover multiple merchants. In fact, the entirety of the description, as highlighted by the above quotes from the article, is devoid of even a hint of multiple merchants, since the system is exclusively single merchant-centric and not extendible to multiple merchants. In fact, the concept of multiple merchants and a unified database spanning multiple merchants are contrary to all aspects of the teachings of the Chain Store Age article.

The Brumback et al. Publication discloses a number of electronic shopping systems in vague detail. These include video-disk review of a store's products, online review of a store's products, a mall kiosk system that provides gift suggestions for a customer, and a store-specific bridal registry. Again, as with the Chain Store Age Publication, the various stores are each independently operational, and the Brumback et al. Publication simply provides the customer with a single gateway by which to browse the various stores in the electronic mall on a seriatim basis, with each store maintaining its independence from the other stores. Thus, there is no suggestion to provide a unified database of registry information, where the data entries are distinguished by a "unique identifier associated with the particular merchant having each of the desired gifts," as is specifically recited in Appellant's independent claims.

The Examiner quotes Brumback et al.'s description of the kiosk which supports Appellant's arguments that Brumback et al. is devoid of customer gift registry data stored in a common database or a list of the goods desired by the registrant

wherein the list includes information about the particular merchant each gift is from.

In fact, the Examiner's quote specifically states that the **only** printed output from the kiosk is "**a map and directions from the kiosk**" – no merchant-specific product information or any suggestion of a gift registry which spans multiple merchants or a unified database of gifts that includes merchant identification data.

Therefore, **both** references treat the shopping experience as an individual store-centric experience and **no customer gift registry data** is stored in a common database or **a list of the goods desired by the registrant wherein the list includes information about the particular merchant each gift is from.** especially since the Brumback et al. Publication is shopping oriented and fails to teach a gift registry system. The references, therefore, are devoid of Appellant's claimed "a portable input and storage device ... receiving and storing information regarding the registrant's desired gifts including the merchant each desired gift is from, wherein the input and storage device stores a unique identifier for the particular merchant each desired gift is from" or "a prospective purchaser interface device that allows a prospective purchaser to view a list of the goods desired by the registrant wherein the list includes information about the particular merchant each gift is from."

REQUIREMENTS FOR A VALID OBVIOUSNESS REJECTION

Appellant submits that the 35 U.S.C. §103(a) rejections of claims 9 – 14 set forth in the Final Office Action dated 09 July 2008 fail to set forth a prima facie showing of obviousness because:

the Examiner has failed to cite and apply references which contain all of the claimed elements or limitations of Appellant's claimed invention.

None of the prior art relied upon by the Examiner in the rejection of claims 9 – 14 contains the following elements or limitations recited in Appellant's independent claims:

- 1.) a portable input and storage device for use by the registrant with a plurality of participating merchants, the input and storage device being capable of receiving and storing information regarding the registrant's desired gifts including the merchant each desired gift is from, wherein the input and storage device stores a unique identifier for the particular merchant each desired gift is from; and

2.) a prospective purchaser interface device that allows a prospective purchaser to view a list of the goods desired by the registrant wherein the list includes information about the particular merchant each gift is from.

SUMMARY

Appellant believes that claims 9 – 14 are allowable under 35 U.S.C. §103(a) over the cited references for the reasons articulated above.

In view of the above remarks, Appellant believes the pending application is in condition for allowance. It is believed no fee is due. If any fee is due, please charge our Deposit Account No. 50-1848, under Order No. 013212.0137R1US from which the undersigned is authorized to draw.

Respectfully submitted,
PATTON BOGGS LLP

Dated: September 16, 2009

By: /James M. Graziano/
James M. Graziano
Registration No.: 28,300
(303) 830-1776

Customer No. 24283

(303) 894-9239 (Fax)
Attorney for Appellant